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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05725.0830-00

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on _____

Signature _____

Typed or printed name _____

Application Number

09/765,675

Filed

January 22, 2001

First Named Inventor

Véronique DOUIN

Art Unit

1617

Examiner

Gina YU

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor./Louis Troilo/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

LOUIS M. TROILO

Typed or printed name

☒ attorney or agent of record.Registration number 45,284202-408-6020

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

January 13, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms is submitted.

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Customer No. 22,852
Attorney Docket No. 05725.0830-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Véronique DOUIN et al.)	Group Art Unit: 1617
)	
Application No.: 09/765,675)	Examiner: Gina YU
)	
Filed: January 22, 2001)	
)	
For: NANOEMULSIONS COMPRISING AT LEAST)	Confirmation No.: 6349
ONE AMPHIPHILIC LIPID, AT LEAST ONE)	
OIL, AND AT LEAST ONE CATIONIC)	
POLYMER, AND USES THEREOF)	

MAIL STOP: AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the Final Office Action mailed July 13, 2005, the period for response having been extended to January 13, 2006, by the Petition and fee filed herewith, Applicants respectfully request panel review of this application. This Request is being filed in conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, appeal fee payment, and completed form PTO/SB/33. No amendments are being filed with this Request.

REMARKS

I. Rejections Under 35 U.S.C. § 103(a)

Claims 1-62 and 64-83 are pending in this application and currently stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the various combinations of references listed at pages 2-3 of the Final Rejection.

Applicants respectfully submit that each of these rejections, as independently addressed below, is in error and should be withdrawn because the Examiner has not established a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must at least teach or suggest all of the claim limitations and must provide a suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references. See M.P.E.P. § 2143. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See M.P.E.P. § 2143.01.

A. Restle in view of Ziegler, Margosiak, and Knowlton

Claims 1-19, 21-23, 28-62, and 68-83 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over EP 0 842 652 A1 ("Restle") in view of U.S. Patent No. 5,135,748 ("Ziegler"), U.S. Patent No. 6,533,873 ("Margosiak"), and POUCHER'S PERFUMES, COSMETICS, AND SOAPS: EMULSION THEORY ("Knowlton"). Final Rejection at 2.

Although acknowledging that Restle and Ziegler "fail to teach the nanoemulsion whose average oil particle size of 150 nm has the [claimed] turbidity," the Examiner nevertheless asserts:

"It would have been obvious to one of ordinary skill in the art that the Restle nanoemulsion whose average particle size of oil globules is smaller than 150 nm is translucent to transparent, as suggested by Knowlton, and has a turbidity at or below 150 NTU, as suggested by Margosiak et al.

Non-Final Office Action of December 23, 2004, at 4-5.

If the Examiner is alleging that it would have been obvious to modify the composition of Restle to have a turbidity ranging from 60 NTU to 600 NTU, she presents no evidence to

support this position, other than an ineffective statement that “the claimed invention is viewed so closely identical to the prior art.” Advisory Action at 2. However, this statement does not mask the Examiner’s underlying position that the nanoemulsion of Restle has the claimed properties based on the alleged evidence provided by Knowlton and Margosiak. In other words, the Examiner’s rejection is clearly based on an inherency position, no matter how it is described.

In reality, the very references that allegedly support the Examiner’s position actually cut against inherency and obviousness since they do not teach or suggest the alleged combination. For example, at p. 522 Knowlton teaches that “it is foolish to generalize on the correlation of emulsion appearance with the size of the dispersed phase particles.” Thus, it would not be obvious to one skilled in the art, and certainly not inherent, that the composition of Restle would have a certain appearance, let alone the claimed turbidity.

In addition to asserting that the nanoemulsion of Restle has a certain appearance based on the “foolish” generalization of Knowlton, the Examiner also asserts that the nanoemulsion would have the claimed turbidity because Margosiak discloses a transparent shower gel with the claimed turbidity. As is clear from the disclosure of Knowlton, there is no basis for the Examiner’s tenuous chain of reasoning.

As stated, in response to Applicants’ arguments, the Examiner eventually took the position that “[one] skilled in the art would have had [sic] ‘combined’ the teachings of the prior arts [sic] to achieve the claimed invention, as the claimed invention is viewed so closely identical to the prior art.” Advisory Action at 2. This reasoning is not sufficient to provide the motivation necessary to combine the teachings of the prior art and establish a *prima facie* case of obviousness because there is nothing within the references to suggest the alleged combination. See M.P.E.P. § 2143.01.

Without some teaching, suggestion, or motivation beyond the tenuous string of generalities to modify the composition of Restle, an obviousness rejection is improper because there is no *prima facie* case of obviousness. The rejection also fails under an inherency theory because the references clearly demonstrate that the claimed properties are not necessarily present. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112. For at least these reasons, Applicants respectfully request the reconsideration and withdrawal of this rejection.

B. Restle in view of Ziegler, Knowlton, Margosiak and Simonnet

Applicants respectfully traverse the Examiner's rejection of claims 24-27 under 35 U.S.C. § 103(a) as allegedly obvious over Restle in view of Ziegler, Knowlton, Margosiak and EP 0 781 114 A1 ("Simonnet") because the combination does not teach all of the claim elements. As Simonnet does not teach or suggest a nanoemulsion having a turbidity ranging from 60 NTU to 600 NTU, this reference fails to cure the deficiencies described in section IA, *supra*. Thus, Applicants respectfully request the withdrawal of this rejection.

C. Restle in view of Ziegler, Margosiak, Knowlton, Simonnet, and Matzik

Applicants respectfully traverse the Examiner's rejection of claim 20 under 35 U.S.C. § 103(a) as allegedly obvious over Restle in view of Ziegler, Margosiak, Knowlton, Simonnet, and U.S. Patent No. 5,716,418 ("Matzik") because the combination does not teach all of the claim elements. As Matzik does not teach or suggest a nanoemulsion having a turbidity ranging from 60 NTU to 600 NTU, this reference fails to cure the deficiencies described in sections IA and IB, *supra*. Thus, Applicants respectfully request the withdrawal of this rejection.

D. Restle in view of Ziegler, Margosiak, Knowlton, Simonnet, Matzik, and Decoster

Applicants respectfully traverse the Examiner's rejection of claims 64-67 under 35 U.S.C. § 103(a) as allegedly obvious over Restle, Ziegler, Margosiak, Knowlton, Simonnet, Matzik and JP H10-338899 ("Decoster") because the Examiner has failed to establish a *prima facie* case of obviousness.

As discussed on pages 12-15 of the Response After Final, the references provide no motivation to combine the references in the manner alleged by the Examiner because Decoster clearly requires a specific combination of compounds to achieve the alleged conditioning benefit. Thus, one skilled in the art would have no reasonable expectation of success in the combination alleged by the Examiner by only adding the aminosilicone because there is nothing to suggest that the resulting composition would provide the same benefit. Furthermore, the references provide no motivation to add all of the required compounds of Decoster to the composition of the combination of references. This rejection is solely based on impermissible hindsight reconstruction to pick and choose only the claimed elements from the references with no regard for the true teachings of the references or the expectation of successfully achieving the alleged benefits. Applicants thus request withdrawal of this improper rejection.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of all the rejections. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

/Louis Troilo/

Dated: January 13, 2006

By: _____
Louis M. Troilo
Reg. No. 45,284